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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,405	11/21/2003	Charles Robert Kalmanek JR.	113335CON2	3354

7590 01/26/2005

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EXAMINER
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BUI, BING Q

ART UNIT	PAPER NUMBER
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2642

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/719,405

Applicant(s)

KALMANEK ET AL.

Examiner

Bing Q Bui

Art Unit

2642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 26-108 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 72-78 is/are allowed.
- 6) ☒ Claim(s) 26-51, 53-71, 79-81, 83-86, 91-95 and 100-104 is/are rejected.
- 7) ☒ Claim(s) 52, 82, 87-90, 96-99 and 105-108 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendment filed on 11/21/03 has been entered. Claims 1-25 have been cancelled. Claims 26-108 are still pending in this application, wherein claims 26, 32, 38, 45, 50, 56, 61, 65, 72, 79, 83, 91 and 100 being independent.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 26, 32, 38, 45, 56 and 61 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The feature of "fewer than all of one network entity" is vague and indefinite because network entity is not expressed in "a real number" that allows us to say fewer than all "1". For example, a SSP is "one" network entity; saying "fewer than all one SSP" such as .9SSP, .8SSP and so on is acceptable only if SSP is expressed in "real number". However, one network entity is expressed as "integer 1".

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 2642

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 26-51, 53-71, 79-81, 83-85, 91-94 and 100-102 are rejected under 35 U.S.C. 102(e) as being anticipated by Farris et al (US Pat No. 5,864,614), herein after referred as Farris.

Regarding claim 26, referring to Figures 1-2 and 7-9, Farris teaches a method for use in a network in which a least a first message for establishing a call is routed from a calling party to a called party through one or more-network entities and in which at least one subsequent message for establishing said call is routed between said calling party and said called party through fewer than all said network entities (see col. 8, lns 17-31 and col. 14, ln 21-col. 15, ln 7).

Regarding claim 27, referring to Figures 1-2 and 7-9, Farris teaches the invention of claim 26 wherein at least one of said one or more network entities is a gate controller and wherein said at least one subsequent message is not routed through said gate controller (see col. 8, lns 17-31 and col. 14, ln 21-col. 15, ln 7).

Regarding claim 28, referring to Figures 1-2 and 7-9, Farris teaches the invention of claim 26 wherein said first message is a setup message for the call and wherein said at least one subsequent message is an end-to-end message (see col. 8, lns 17-31 and col. 14, ln 21-col. 15, ln 7).

Regarding claim 29, referring to Figures 1-2 and 7-9, Farris teaches the invention of claim 26 wherein said first message is a setup message for the call and wherein said at least one subsequent message is one of a ring message, a ringback message and a connect message (see col. 8, lns 17-31 and col. 14, ln 21-col. 15, ln 7).

Regarding claim 30, referring to Figures 1-2 and 7-9, Farris teaches the invention of claim 26 wherein said establishing includes a setup phase during which the routing of said first message is carried out and a connection phase during which the routing of said at least one subsequent message is carried out (see col. 8, lns 17-31 and col. 14, ln 21-col. 15, ln 7).

Regarding claim 31, referring to Figures 1-2 and 7-9, Farris teaches the invention of claim 26 wherein said at least one subsequent message is routed through a NAT/PAT server (see col. 8, lns 17-31 and col. 14, ln 21-col. 15, ln 7).

As to claims 32, 38, 56-57 and 61, they are rejected for the same reasons set forth to rejecting claim 26.

As to claims 33, 41, 43, 46, 55, 64-66, 68, 81, 83 and 100, they are rejected for the same reasons set forth to rejecting claim 27.

As to claims 35, 40 and 47, they are rejected for the same reasons set forth to rejecting claim 28.

As to claims 36, 42, 48, 51, 58, 63, 67, 80, 84, 93 and 101, they are rejected for the same reasons set forth to rejecting claim 29.

As to claims 34, 39, and 62, they are rejected for the same reasons set forth to rejecting claim 30.

As to claims 37, 44 and 49, they are rejected for the same reasons set forth to rejecting claim 31.

Regarding claim 45, referring to Figures 1-2 and 7-9, Farris teaches a method for use in a network to establish a call from a calling party to a called party, the method comprising communicating to the called party a setup message for the call that originated from the calling party, said call setup message being processed by one or more network entities of said network; subsequently communicating to the calling party a setup acknowledgement message from the called party to the calling party, the setup acknowledgement message being processed by each of said one or more network entities; and subsequently communicating between the calling and called parties at least one signaling message, said at least one signaling message being routed through fewer than all of said one or more network entities (see col. 8, lns 17-31 and col. 14, ln 21-col. 15, ln 7).

Regarding claim 53, referring to Figures 1-2 and 7-9, Farris teaches the invention of claim 50 wherein said end-to-end signaling messages are opaque to any entities in said network that perform said routing (see col. 8, lns 17-31 and col. 14, ln 21-col. 15, ln 7).

Regarding claim 54, referring to Figures 1-2 and 7-9, Farris teaches the invention of claim 53 wherein at least one of said entities in said network that performs said routing performs network address translation (see col. 8, Ins 17-31 and col. 14, In 21-col. 15, In 7).

Regarding claim 69, referring to Figures 1-2 and 7-9, Farris teaches the method of claim 65, wherein the end-to-end message is routed through a network edge device, the network edge device being associated with the calling party and connecting a first network to a second network, the calling party being associated with the first network, the gate controller being connected to the second network (see col. 8, Ins 17-31 and col. 14, In 21-col. 15, In 7).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 86, 95, and 103-104 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farris '614.

Regarding claims 86, 95, and 103-104, Farris fails to teach the setup - message includes a destination address for the called party and wherein said at least one end-to-end message includes a different address for the called party. However, this feature implemented in intelligent network is well known in the art. For example, for a call forwarding subscriber, a call dialed by a caller to a first address is forwarded to a second address different from the first address when the first address is busy or no answer.

#### ***Allowable Subject Matter***

9. Claims 72-78 are allowed.

10. Claims 52, 82, 87-90, 96-99 and 105-108 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents are cited to further show the state of the art in general:



U.S. Pat. No. 5,734,710

U.S. Pat. No. 5,764,744

U.S. Pat. No. 5,852,657

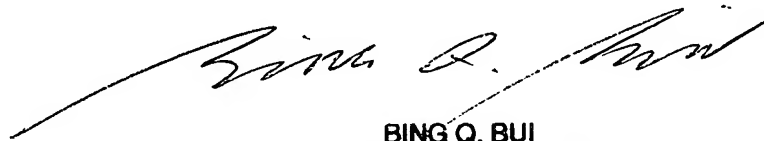
U.S. Pat. No. 6,175,574

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bing Bui whose telephone number is (703) 308-5858. The examiner can normally be reached on Monday through Thursday from 7:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on (703) 305-4731. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306 and for formal communications intended for entry (please label the response ☐EXPEDITED PROCEDURE☐) or for informal or draft communications not intended for entry (please label the response "PROPOSED" or "DRAFT").

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

14 JAN 2005



BING Q. BUI  
PRIMARY EXAMINER